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08/14/2003

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,484

Applicant(s)

LAI ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/03 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The Applicants' response to restriction requirement filed on July 7, 2003 was received.

Applicant's election without traverse of the invention of Group I in Paper No. 5 is acknowledged.

Claims 7-24 are deleted.

Claim Objections

3. Claim 25 is objected to because of the following informalities:

Should "x" (second line from bottom) be -- y -- as shown in the formula above?

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by

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raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "C6-30 aromatic substituents" (line 12), and the claim also recites "such as for example but not limited to phenyl" (lines 12-13) which is the narrower statement of the range/limitation. The same rejection applies to "preferably" recited in Claim 1 (line 21).

In Claim 1 (line 21), should "-CO-U-R₁" be -- --CO-U -- because U is a monovalent radical as indicated in the end of the instant claim?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogler (US 4 929 051).

Rogler discloses an organopolysiloxane having a formula described in col. 5, lines 20-28, wherein R¹ can be C1-C4 alkyl and/or phenyl and/or aralkyl, Q can be a (meth)acrylate of diol (col. 3, line 40 to col. 4, line 8), R² can be trimethylene, tetramethylene, etc (col. 4, lines 50-68), c can be 1, d can be up to 1000 and e can be 0 (col. 5, lines 29-30). Note that the instant

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organopolysiloxane reads on Applicants' prepolymer wherein x is 1, R₃ is H, R₄ is H, L is –OC(O)O–, p is 0, (W)_q is –C(O)—, R₅ is C1-C10 alkylene, R is C1-C4 alkylene, (Z)_q is –O–, (Ar)_q is absent (q = 0), y is up to 1000 (i.e., the prepolymer molecular weight is at least approximately 1000). Furthermore, R¹ in Rogler's organopolysiloxane consists of a minimum of 20% phenyl or aryl residues (col. 4, lines 35-45). Since Roger's organopolysiloxane reads on Applicants' prepolymer, they should have the same refractive indexes. *In re Best*, 195 USPQ 430 (CCPA 1977).

8. Claim 25 would be allowable if rewritten or amended to overcome the claim objection, set forth in this Office action.

Rogler does not teach or fairly suggest a prepolymer containing urethane linkages derived from IPDI and –(CH₃)PhSiO– units.

Ito (US 5 855 825) discloses a polysiloxane prepolymer (col. 7, lines 8-56). However, Ito does not teach or fairly suggest the prepolymer of the present invention. Especially, although Ito discloses polysiloxane prepolymers containing linkages derived from IPDI (col. 22, lines 5-22 and Claims 8, 16 and 20), the instant polysiloxane prepolymer does not a) contain any –(CH₃)PhSiO– units, b) contain a tetramethylene linkage between the Si atom and the nearest –NHC(O)O–, rather it contains –CH₂CH₂O–CH₂CH₂CH₂– linkage and c) a refractive index of at least approximately 1.45.

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9. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Rogler discloses a polysiloxane prepolymer containing carbonate linkages having a molar ratio of aromatic substituents to alkyl substituents no less than 1:4 as described in paragraph 7. However, it does not teach or fairly suggest a polysiloxane prepolymer containing urethane linkages having a molar ratio of aromatic substituents to alkyl substituents no less than 1:4.

Ito (US 5 855 825) discloses a polysiloxane prepolymer containing urethane linkages (col. 7, lines 8-56). However, Ito does not teach or fairly suggest that the polysiloxane prepolymer having a aromatic substituents to alkyl substituents of no less than 1:4 and having a refractive index of at least approximately 1.45.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
August 6, 2003

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